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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/902,153	07/29/1997	KEN HASHIMOTO	826.1410/JDH	9897

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EXAMINER

KINCAID, LESTER G

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 06/19/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/902,153

Applicant(s)

HASHIMOTO, KEN

Examiner

Lester G. Kincaid

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-9,11-19,21-23,25-27 and 34-61 is/are pending in the application.
- 4a) Of the above claim(s) 2-9,11-19,21-23,25-27 and 34-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Prosecution Application***

1. The request filed on 3-25-03 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/902,153 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 39-43** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claims 39-43** recite the limitation "said portable information terminal". There is insufficient antecedent basis for this limitation in these claims, since the base claim recites a "portable information terminal" in line 3 and "another portable information terminal" in line 20.

Please note, claims 40 and 44 appear to be duplicate claims to claim 38 and claims 49 and 56 appear to be duplicate to claim 47.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 38, 40, 44, 47, 49, 56, 60 and 61** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sprague et al. (U.S. Patent 5,661,652) in view of Hoffman et al. (U.S. Patent 5,742,233) and Norris (U.S. Patent 5,689,269).

As to **claims 38, 40, and 44**, Sprague et al. disclose a position information management system, comprising:

a portable information terminal (20/22); and

a central system (12,24).

The portable information terminal comprising:

GPS receiver (see col. 1, line 57 - col. 2, line 5 and col. 2, lines 54-67); and

a position registering unit automatically registering position information periodically with central system, (see col. 5, lines 27-35). Wherein a position of a first party holding terminal (20) may be obtained, through the central system, by a second party holding another terminal (22). Sprague et al. fail to explicitly recite that the portable information terminal include an automatic responding unit and wherein the positions of both parties are displayed on the second terminal, although Sprague et al. disclose (in Fig. 3) displaying the first party and a relative distance (from the second party). See col. 4, line 58 - col. 5, line 10.

The central system comprising: a positional information acquiring unit (see col. 5, lines 27-31). Sprague et al. fail to explicitly recite that the central system include a

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request receiving unit and fail to explicitly recite that the acquiring unit sends commands.

In an analogous art, Hoffman et al. disclose a position information management system in which the central system includes a request receiving unit and an acquiring unit that sends a command to the terminal which automatically responds with its position (see col. 6, lines 50-60, col. 8, lines 16-21 & 35-39, col. 11, line 58 - col. 12, line 46, and col. 13, lines 42-56) in order to allow a second party to locate a person "as needed". It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sprague et al. by specifically having the central system include a request receiving unit, having the acquiring unit send a command to the terminal, and having the terminal automatically respond to the command, as taught by Hoffman et al. for the purpose of enabling a second party to locate a first party when needed.

In an analogous art, Norris discloses wherein it was advantageous to display the positions of both parties (see Figs. 7-8) in relative fashion to aid parties in locating one another. It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the system of Sprague et al. by specifically having the terminal display both parties, as taught by Norris, for the purpose of aiding parties in locating the other.

**Claims 47, 49, 56, 60 and 61** are broader in scope and thus read on the combination as applied above.

6. **Claims 39 and 48** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sprague et al. in view of Hoffman et al. and Norris as applied to claim 38 above, and further in view of Geier et al. (U.S. Patent 5,416,712).

Sprague et al. further disclose wherein the terminal comprises a built-in device which detects a moving direction and speed of the terminal (see col. 5, lines 1-5)., however Sprague et al. fail to explicitly recite that the terminal independently detects and displays its position when GPS is unavailable.

In an analogous art, Geier et al. discloses wherein it was advantageous for a terminal to independently detect and display its position when GPS is unavailable, thereby enabling a device to bridge the gap caused by a GPS signal outage. See col. 1, line 51 - col. 2, line 65. It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the system of Sprague et al. by specifically having the terminal independently detect and display its position when GPS is unavailable, as taught by Geier et al. for the purpose of enabling a user to still provide current location data even when it would otherwise be unavailable.

7. **Claims 39, 41-43, 45-46, 47, 50-55, and 57-59** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sprague et al. in view of Hoffman et al. and Norris as applied to claim 38 above, and further in view of applicant's admitted prior art.

Sprague et al. fail to explicitly recite each of the depending details, however applicant hasn't described them, in the instant specification, in such detail as to enable

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one of ordinary skill in the art to perform (make and/or use) such - unless it was already assumed that the details of such were well known. Therefore it is considered that applicant has admitted that the depending details were admittedly well known in the art. It would have been obvious to utilize such details to optimize the operation of the system. Alternatively, the examiner takes official notice that such details were well know and would have been obvious modifications for the purpose of optimizing operation of the system.

### ***Response to Arguments***

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tiedemann, Jr. et al. (U.S. Patent 5,642,398) provide for a terminal which provides its location data to a central system autonomously and/or in response to a command. See col. 7, lines 1-45.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lester G. Kincaid whose telephone number is (703) 306-3016. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 Customer Service Office at (703) 306-0377.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks


Washington, D.C. 20231

**or faxed to:**

(703) 872-9314 (Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

LGK  
June 16, 2003

  
**LESTER G. KINCAID  
PRIMARY EXAMINER**